AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/534,562
Attorney Docket No.: Q58495

REMARKS

General remarks

Claims 1-11 are all the claims pending in the application. By this Amendment, Applicant editorially amends claims 1, 5-6, and 8-9 to correct minor informalities. The amendments to claims 1, 5-6, and 8-9 were made for reasons of consistency, and do not narrow the literal scope of the claims and thus do not implicate an estoppel in the application of the doctrine of equivalents. The amendments to claims 1, 5-6, and 8-9 were not made for reasons of patentability.

Office action summary

The Examiner found Applicant's arguments persuasive and withdrew the previous rejections. Claims 1-5 and 8-11 are allowed and claim 7 contains allowable subject matter.

With respect to claim 6, however, the Examiner found new grounds for rejecting the claim. In particular, claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,806,005 to Hull et al. (hereinafter "Hull") in view of U.S. Patent No. 5,96950 to Hsieh et al. (hereinafter "Hsieh"). In addition, the Examiner objected to claims 1, 5 and 8 for minor informalities.

Claim rejections

The Examiner rejected claim 6 under 35 U.S.C. § 103(a) as being obvious over Hull in view of Hsieh. The Examiner's carefully reconsideration is submitted to be appropriate in view of the following comments traversing the rejection.

Independent claim 6 recites:

```
output  means  for  outputting  the  desired
image  data  to  be  printed  from  the  first
memory  sections  to  an  external  printing
apparatus...
```

The Examiner asserts that claim 6 is directed to an image data processing system and is obvious in view of Hull and Hsieh. The Examiner acknowledges that Hsieh does not teach or

6

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/534,562
Attorney Docket No.: Q58495

suggest the output means, as set forth in claim 1 (page 2 of the Office Action). The Examiner, however, asserts that Hull's portable image transfer system teaches outputting the desired image data to be printed from the first memory section to an external printing apparatus (page 3 of the Office Action).

Hulls' discussion of the portable image transfer system has been carefully studied, and such teachings in Hull are very dissimilar from the subject matter of claim 6. For example, Hull teaches an image transfer system 10, which has a remote station 12 (which has a camera 20), coupled to a server station 14 via a cellular network 16 (Fig. 1; col. 1, line 65 to col. 2, line 1). In addition, the server station 14 may also be coupled to an external printing device 70 (Fig. 1; col. 4, lines 36 to 44). Hull teaches that many uses are contemplated with respect to the remote station 12 being connected to the server station 14 and describes some of these uses in detail (col. 2, lines 63 to 66).

In particular, Hull teaches that the server station 14 has an image storage device 58, which can be used to store images when the image memory of the camera is full (col. 2, line 67 to col. 3, line 33). In addition, the image stored in image storage device 58 can be made available on the Internet (using a TCP/IP connection). In short, Hull teaches using the storage device 58 to store images and to display them on the Internet. Hull does not teach or suggest printing images from this image storage section.

Another use for Hull's system is to obtain photocopies in locations such as libraries, where it is not convenient to bring the item to be copied to a photocopy machine (col. 3, lines 60 to 64). That is, Hull teaches the user requesting a hardcopy of a particular image via command input 32 and the image being sent to the server station 14, where its resolution is adjusted via CPU 52 and it is sent to the printing device 70. Alternatively, the image may be sent directly from the remote station 12 to the printing device 70 (Fig. 1, col. 4, lines 15 to 46).

Hull, however, teaches printing an image only from the remote station 12 and in an alternative use of the system, storing image data in the storage 58 for various other purposes. In other words, Hull teaches printing the image sent from the remote station 12 by only using the CPU 52 of the server station 14 to edit the image. There is no teaching or suggestion that the

7

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/534,562
Attorney Docket No.: Q58495

image is sent for printing from the storage 58. That is, Hull teaches that the images to be printed are sent from image memory 24 of the remote station 12 (e.g., col. 4, lines 4 to 5) either directly to the printer or via CPU (for adjusting the resolution of the images) of the server station 14 (col. 4, lines 4 to 17). In short, Hull is silent as to whether the images can be first stored in storage 58 and then retrieved and processed from the storage 58 as opposed to the remote station 12.

Therefore, *output means for outputting the desired image data from the first memory section to an external printing apparatus,* as set forth in claim 6, is not taught or suggested by Hull or Hsieh, taken alone or in any conceivable combinations. Together the combined teachings of these references would not have (and could not have) led the artisan of ordinary skill to have achieved the subject matter of claim 6. Therefore, it is appropriate and necessary for the Examiner to withdraw this rejection of the independent claim 6.

Claim objections

The Examiner objected to claims 1, 5 and 8 because of minor typographical errors. The claims have been revised, and it is respectfully submitted that the claims as now presented no longer include the typographical errors mentioned by the Examiner. Therefore, it is appropriate and necessary for the Examiner to withdraw the objections to the claims.

Allowable subject matter

The Examiner's indication that claims 1-5 and 8-11 are allowed is gratefully noted. No acquiescence, however, is being made to any inferences or presumptions drawn from the Examiner's statement regarding the reasons for allowance.

The Examiner indicates that claim 7 would be allowable if rewritten in independent form including all the limitations of the base claim and any intervening claims. The rewriting of claim 7 is held in abeyance until the arguments presented with respect to independent claim 6 have been considered.

8

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Application No.: 09/534,562
Attorney Docket No.: Q58495

<u>Conclusion and request for telephone interview</u>

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly invited to contact the undersigned attorney at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.
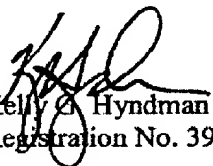
Respectfully submitted,

Kelly G. Hyndman
Registration No. 39,234

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE
23373
CUSTOMER NUMBER

Date: June 24, 2004